

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-46 were pending in this application. Claims 28, 29, 35 and 36 have been amended. Thus, as a result of the foregoing amendment, Claims 1-46 as amended are pending.

The amended claims are shown above without markings. Attached hereto is a version with markings to show the changes made, captioned "Version with markings to show changes made."

Claims 28-29, 35-36 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which Applicant(s) regard as the invention. Applicant(s) have amended claims 28-29 and 35-36 to clarify the expression of the invention as claimed herein. The contents of the amended claims 28, 29, 35 and 36 are fully supported in the description since only clerical self-evident amendments have been made to improve the clarity of these claims and to correct some minor errors.

Claims 1-46 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Hainonen (U.S. Patent No. 6,418,326) in view of Hannula (U.S. Patent No. 6,366,893) and further in view of Jachimowicz (U.S. Patent No. 5,789,733). Applicant(s) have respectfully traversed the Examiner's rejection and have provided evidence for non-obviousness, as shown below.

Claim Rejections under 35 U.S.C. §112

Claims 28-29 and 35-36 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant(s) have amended the claims to more clearly point out and specifically address the characteristics of the invention, as suggested by Examiner. In light of the foregoing, Applicant(s) respectfully request withdrawal of the rejection.

Claim Rejections under 35 U.S.C. §103(a)

Claims 1-46 are rejected under U.S.C. §103(a) as obvious over Hainonen in view of Hannula and further in view of Jachimowicz. This rejection is traversed.

The Examiner has the initial burden of establishing a *prima facie* case of obviousness. A finding of obviousness under § 103 requires a determination of the scope and content of the prior art, the differences between the claimed invention and the prior art, the level of ordinary skill in the art, and whether the differences are such that the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. Graham v. Deere, 383 US 1 (1966). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made. In re Stencel, 828 F2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

The examiner has rejected independent claims 1 and 45 as unpatentable, arguing that it would have been obvious to one skilled in the art at the time of the invention to combine U.S. Patent No. 6,418,326 (Heinonen) in view of U.S. Patent No. 6,366,893 (Hannula) and in view of U.S. Patent No. 5,789,733 (Jachimowicz), in order to cover all the characteristics contained in said independent claim 1.

Applicant(s) respectfully traverse the Examiner's rejections for the following reasons. The subject matter disclosed in Heinonen, Hannula and Jachimowicz **clearly differ** from the contents of independent claims 1 and 45 of the present application; therefore, even considering such obviousness to combine, the contents of said documents do not anticipate the invention disclosed in the present application.

As stated by the Examiner, "Heinonen teaches a system for processing payments between payers and payees using a communication by means of digital telephony":

Applicant(s) note that the invention of Heinonen always relates to the use of specific payment Applications 18 available in specific payment Application Modules 19 contained in specific payment Module Cards 19 coupled within the mobile station 1 (see Figs. 2, 3 (specifically), and 4; col 6 line 41 – col 8 line 39 (specifically col 8 lines 14-19); and claim 1 col 12 lines 53-55 (mobile station comprising control means inside coupled by means of an interface)).

Furthermore, Applicant(s) note that the present application differs from the cited reference in that the **non specific payment** Application, Module nor Card, are required or described in independent claim 1 of the present application (corresponding to the most basic embodiment of the invention) apart from the usual SIM card owned by every

mobile station without any specific payment application. This is due to the fact that the invention of the present application basically works by interchanging SMSs, whereas the control of the payment does not reside in the mobile station 16 (as Heinonen), but in payment and transaction center comprising the account management means 21e included in independent claim 1.

Furthermore, according to Heinonen, the mobile station 1 also comprises first means of data transfer (such as infrared IR transmitter/receiver used to transfer data between the mobile station 1 and a cash register (payment terminal) 21 (Fig.6) or between two different mobile stations 1 belonging to payer and payee, respectively (Fig.7). (See col 5 lines 42-47).

In addition, Applicant(s) note that the present application differs from the cited reference in that according to the present application, **no direct** data transfer is accomplished between the mobile station 16 of the payer and the telecommunication terminal of the payee 16 in any case, but indirectly (and more securely) through a payment and transaction center comprising: first telecommunication means 18, 19, first server 20, first data storage means 22..., as stated in independent claim 1 of the present application.

The examiner states that "Heinonen teaches a first server interconnected with a telecommunication means with storage means (col 5 line 42-col 6 line 3)(Fig.1)":

Fig.1 only relates to the internal configuration of the mobile station 1, therefore no telecommunication means can apply. Likewise, apart from the "computer" mentioned in col 5 line 49 (which corresponds to an embodiment of payment terminal owned by the payee), no first server interconnected with a telecommunication means with storage means seems to appear within the portion of text comprised in col 5 line 42-col 6 line 3. In any case, the computer 22 in the bank (perhaps such "server" referred to) is controlled by the specific payment application residing within the mobile station, **contrary** to what is taught in independent claim 1 of the present application.

The Examiner states that "Heinonen includes account management means":

According to Heinonen, the account management means reside within the mobile station 1 (and therefore with less security), since the account management is carried out by specific payment Applications 18 available in the specific payment Application Modules

19 contained in the specific payment Module Cards 19 coupled to the mobile station 1 (see Figs. 2, 3 (specially) and 4; col 6 line 41 – col 8 line 39 (specially col 8 lines 14-19); and claim 1 col 12 lines 53-55 (mobile station comprising control means inside coupled by means of an interface) and col 12 line 65 to col 13 line 11).

According to the present application, the account management means 20e does not reside within the mobile station 16, but within a server 20 (**not** belonging to the mobile station 16) since said server 20 is interconnected with the mobile station 16 thanks to telecommunication means 18, 19, as described in independent claim 1 of the present application.

Furthermore, according to Heinonen, the specific payment application 18 stores within the mobile station 1 information about the user's bank account (which has been previously retrieved), when a payment is made, the specific payment application 18 of the mobile station reduces the balance of the bank account in the specific payment application 18 within the mobile station and then, said application residing within the mobile station send the new balance of the bank account for the bank to update said bank account (see col 8 lines 14-39, col 10 lines 60-67, and claim 1 col 12 line 65 – col 13 line 11); which is **contrary** to and much less safe than the functionality of what is claimed in independent claim 1 of the present application (where the payment mechanisms only reside in the payment and transaction center comprising: first telecommunication means 18, 19, first server 20, first data storage means 22..., as stated in independent claim 1 of the present application). When desiring to change or increase the functionality/possibilities/capability of the payment procedure, the invention disclosed by Heinonen has a serious disadvantage in comparison with the present application, since in the case of Heinonen all specific payment Applications 18 available in specific payment Application Modules 19 contained in specific payment Module Cards 19 coupled within **each** mobile station 1 of millions of mobile station would have to be changed; but in the case of the present application, only the payment center comprising the account management means 21e would have to be changed.

According to Heinonen, the central processing unit (CPU) in the SIM of the mobile station 1 examines the entered identification number by comparing it to the previously saved identification number (saved in said mobile station) (see col 8 line 52 – col 9 line

5). Again, this is **contrary** and much less safe than the functionality of what is claimed in independent claim 1 of the present application (where the authorization and securing mechanisms reside in the payment and transaction center comprising: first telecommunication means 18, 19, first server 20, first data storage means 22..., as stated in independent claim 1 of the present application).

Although the invention disclosed by Heinonen only accomplishes some of the same **functionality** as that of the invention of the present patent application, the invention disclosed in the present patent application has **significant advantages** and **the mechanisms used are significantly different**. Therefore, the present invention was developed contrary to the teaching of what was known in the art at the time that the invention was made. More specifically, development occurred in a direction that would have discouraged a person skilled in the art to follow at the time the invention was made.

The examiner notes that “Hannula teaches that the telecommunication means comprises a plurality of equipment”:

Applicant(s) point out that the invention of Hannula always relates to the use of protocol conversion means (see protocol conversion means 153 in Figs. 3 and 4, protocol conversion means 22 in Fig. 6, col 4 lines 64-67, col 5 lines 15-16, col 6 lines 2-7 “**conversions and adaptations**”, and claim 1 col 8 line 65 – col 9 line 2).

Applicant(s) note that the present application differs from the cited reference in the following way. According to the present application, in independent claim 1 of the present application a much simpler method is accomplished: selecting means 20h select a compatible telecommunication means 18, 19 based on the data stored in second data storage means (21) containing an association between at least a first information referring to the **admissible telephone number** of each payer **and** at least a second information referring to the **type of digital mobile telephone**, as described in independent claim 1 of the present application. This avoids the use of a continuous conversion (on-line translation or adaptation) between different protocols which requires machines with high processing power in order to avoid slowing down the communication. Hannula does **not** consider this possibility since, as stated in col 6 lines 11-16, the payment service database 11 stores data related to the **payment** service such as amount of credit available or digital cash available (not the type of compatible telecommunication required); furthermore, in

col 6 lines 16-17 is said that the database is not necessarily needed, therefore discarding, in the case of Hannula, the possibility that the conversion was made by means of an association between at least a first information referring to the admissible telephone number of each payer and at least a second information referring to the type of digital mobile telephone, neither stored in any database nor used by selecting means.

Although as stated by the Examiner, Hannula teaches “authorization of payments”: the flow and order of the processes related with such authorization of payments significantly differs from what is described in independent claim 1 of the present application (see Hannula col 5 lines 19-26 and col 7 lines 36-62).

Although the invention disclosed by Hannula accomplishes only some of the same **functionality** of the invention of the present application, the invention disclosed in the present patent application has **significant advantages and the mechanisms used are significantly different**. Therefore, the present invention was developed contrary to the teaching of what was known in the art at the time that the invention was made. More specifically, development occurred in a direction that would have discouraged a person skilled in the art to follow at the time the invention was made.

As noted by the Examiner, “Jachimowicz teaches authorization means and verifying means” and cites col 3 lines 42-56 and col 1 lines 46-59.

Applicant(s) contend that combining the invention of Jachimowicz could not have been obvious since it has no relationship with either financial transactions nor with employing radio-telephony; just with smart cards by using the properties of Optics.

Given the foregoing arguments, Applicant(s) believe that the current US application is novel and inventive over the devices disclosed in said documents, since none of them includes **all** of the characteristics contained in independent claim 1 and in independent claim 45, neither taken alone nor in combination since each employs quite different methods to that disclosed in the independent claims.

Based on the foregoing, Applicant(s) contend that dependent claims 2-44 and 46 are also novel.

In light of the foregoing arguments, Applicant(s) respectfully request withdrawal of the rejections.

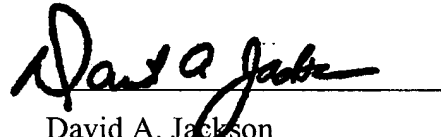
Fees

A check in the amount of \$ 930 for a three-month extension of time is enclosed. No other fees are believed to be required, but if so, the Commissioner is hereby authorized to charge any fees, or credit any overpayment, to Deposit Account No. 11-1153.

Conclusion

Applicants believe that the foregoing amendments to the claims place the application in condition for allowance. Withdrawal of the rejections is respectfully requested. If a discussion with the undersigned will be of assistance in resolving any remaining issues, the Examiner is invited to telephone the undersigned at (201) 487-5800, ext. 105, to effect a resolution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David A. Jackson", is written over a horizontal line.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

28. (Amended) A system according to claim 27, wherein the fifth information further comprises a first selectable telephone number comprised of one of said reference codes and an identification code of the [corresponding] payee (14, 46) which [and that] constitutes the admissible identification code.

29. (Amended) A system according to claim 27 or 28, wherein the fifth information further comprises the admissible identification code [as] by means of an access telephone number of the payee (14,46); said access telephone number being associated to at least a first menu comprised of the reference codes, the products or services identified respectively by each of said reference codes and the price of each of said products or services.

35. (Amended) A system according to claim 1, wherein the first verifying means (20a) of the first server (20) further comprise complementary verifying means [(20g)] (20q) being associated to the selecting means (20h), for verifying if the admissible identification code that has been verified by the first verifying means (20a) in said first message received from a payer (13) identified by a first admissible telephone number [and] containing a transaction request that has been verified by the second verifying means (20b), corresponds to a second admissible telephone number from among the admissible telephone numbers of a digital mobile telephone (41) comprised within the first information contained in the first data storage means [(22) and if the first message identifies] (22) [the second admissible telephone number as identification of a payee (40),] the complementary verifying means (20q) generating a fourth acceptance message [when detecting that said second admissible telephone] if said complementary verifying means detect that the second admissible telephone number corresponds to a payee (40), said fourth acceptance message being processable by the confirmation message

generating means [(20g), and wherein] (20g) the rejection message generating means (20f) generate a rejection message [when] if the fourth message has not been generated.

36. (Amended) A system according to claim 35, wherein

the confirmation message generating means (20g) generate[, when detecting the first, second, third and fourth acceptance message,] a first confirmation message if said confirmation message generating means detect the first, second, third and fourth acceptance message, said first confirmation message containing an identification of the payer (13), an identification of the transaction and a petition for conformity to the payee (40) identified in the first message; said petition for conformity comprising a request of transmission of the safety parameter, [and transmit said] said confirmation message generating means transmitting the confirmation message to the mobile telephone (41) of the payee (40) identified by the second admissible telephone number through the telecommunication means (18,19) selected by the selecting means;

the third verifying means (20c) furthermore verify if the safety parameter transmitted from the mobile telephone (41) in response to the petition for conformity, satisfies the safety criterion associated to the second admissible telephone number, said third verifying means (20c) generating a fifth acceptance message when said parameter satisfies said safety criterion;

the authorization means (20e) authorize the account management means (20d) when said fifth acceptance message has been generated;

the confirmation message generating means (20g) generate and transmit a second confirmation message to the mobile telephone (16) of the payer (13) and to the mobile telephone (41) of the payee [(41)] (40).